UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
JAKOVAC, RYAN J

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>24 January 2011</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>31-51,53-79 and 81-88</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>31-51, 53-79, and 81-88</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is in response to communications filed 01/24/2011. Claims 31-51, 53-79, and 81-88 are currently pending.

Continued Examination Under 37 CFR 1.114

2.   A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed 01/24/2011 has been entered.

Response to Arguments

3.   Applicant's arguments filed 01/24/2011 have been fully considered.

4.   Applicant's argue in summary that the cited reference to not teach or suggest:
         "generating, from at least a portion of an electronic message, identification data that uniquely identifies said electronic message and distinguishes said electronic message from other electronic messages authorized by an o*riginator"*

5.   With regards to the Applicant's arguments and amended claim language, new grounds of rejection are set forth below.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.   The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459

(1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

     1.   Determining the scope and contents of the prior art.

     2.   Ascertaining the differences between the prior art and the claims at issue.

     3.   Resolving the level of ordinary skill in the pertinent art.

     4.   Considering objective evidence present in the application indicating obviousness

         or nonobviousness.

8.   **Claims 31-36, 38-51, 53-54, 56-79, 81-88 are rejected** under 35 U.S.C. 103(a) as being

unpatentable over US 20030220978 to Rhodes in view of "Recommendations for generating

Message IDs" by Matt Curtin (hereinafter Curtin).

     Regarding independent claims 31, 47, and 76, Rhodes teaches a method comprising:

     associating with an electronic message authorized by an originator identification data

uniquely identifying said electronic message, (Rhodes, fig. 8, email message with originator key.

See [0058-0059].);

     storing said identification data (Rhodes, [0058-0059].);

     sending to an intended recipient said electronic message with said identification data

(Rhodes, [0058-0059], fig. 8, message sent to recipient including originator key.);

     receiving on behalf of the intended recipient a confirmation request including said

identification data and requesting confirmation that the said electronic message was authorized

by they originator (Rhodes, fig. 8, challenge message.);

     comparing said identification data received in said confirmation request to said stored

identification data (Rhodes, [0058-*0059], fig. 8, "On the sender*-side SVP, the parsed challenge

message is examined to determine if it contains a known Originator Key at *811.*"); and

     upon determining that said identification data received in said confirmation request

matches said stored identification data, responding to said confirmation request, affirming said

electronic message was authorized by the originator (Rhodes, [0058-0059], response to

challenge message. See also [0047-0053] and fig. 7.).

Rhodes does not expressly disclose generating, from at least a portion of an electronic message, identification data that uniquely identifies said electronic message and distinguishes said electronic message from other electronic messages authorized by an originator.

However, Curtin discloses generating, from at least a portion of an electronic message, identification data that uniquely identifies said electronic message and distinguishes said electronic message from other electronic messages authorized by an originator (Curtin, pg. 2/5, section 1-3, Curtain discloses the generation of unique message IDs which are generated from a portion of the electronic message. Pg. 3/5-4/5, unique ID is generated using a hash of the message.).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Curtin and Rhodes in order to uniquely identify messages (Curtin, pg. 2/5, section 1.).

Regarding the additional limitations of claim 76, "receiving from the sending device a second electronic message different from said first electronic message authorized by the originator, said second electronic message containing information identifying the originator; and sending the confirmation device a second confirmation request requesting confirmation that said second electronic message was authorized by the originator", the combination of Rhodes and Curtin discloses these limitations as described above since these limitations amount to repeating the known method disclosed by Rhodes and Curtin as described above. For example, Rhodes and Curtin describe the method and it is understood that the process is repeated, for example, receiving a second message and sending a second confirmation request (See Rhodes, [0058-0059], fig. 8.).

Regarding dependent claims 32, 48, the combination of Rhodes and Curtin teaches the method of claim 31, wherein said electronic message includes one of a text message, VoIP message, or instant message (Curtin, pg. 2/5, internet messages.).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Curtin and Rhodes in order to uniquely identify messages (Curtin, pg. 2/5, section 1.).

Regarding dependent claims 33, 49, the combination of Rhodes and Curtin teaches the method of claim 31, wherein said identification data is derived at least in part from information contained in one or more of a message header, a message text, and a timestamp, of said electronic message (Curtin, pg. 2/5-4/5.).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Curtin and Rhodes in order to uniquely identify messages (Curtin, pg. 2/5, section 1.).

Regarding dependent claims 34, 50-51, the combination of Rhodes and Curtin teaches the method of claim 31,

wherein said identification data is included in a message header of said electronic message (Rhodes, fig. 4-6.), and

wherein said identification data is alphanumeric string (Rhodes, [0040-0041].).

Regarding dependent claims 35, 46, 54, the combination of Rhodes and Curtin teaches the method of claim 31, wherein said sending includes attaching said identification data as an attachment to said electronic message (Rh*odes, [0041], "The message body typically includes* text, attachments, links, and the like that comprise the information the sender desires to convey to the recipient. In accordance with the present invention, senders who are using a sender verification pro*tocol include an Originator Key value in the message body.")*.

Regarding dependent claims 36, 53, the combination of Rhodes and Curtin teaches the method of claim 31, wherein said identification data is included in said message text (Rhodes, [0041].).

Regarding dependent claims 37, 55, the combination of Rhodes and Curtin teaches the method of claim 31, further comprising calculating a checksum for said message text; and including said checksum in said identification data (Curtin, pg. 2/5, section 1-3, Curtain discloses the generation of unique message IDs which are generated from a portion of the electronic message. Pg. 3/5-4/5, unique ID is generated using a hash of the message.).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Curtin and Rhodes in order to uniquely identify messages (Curtin, pg. 2/5, section 1.).

Regarding dependent claims 38-43, 56-61, the combination of Rhodes and Curtin teaches the method of claim 31, wherein said receiving a confirmation request includes receiving said confirmation request via port-to-port communication (Rhodes, fig. 8. See also fig. 2-3.).

Regarding dependent claims 44-45, the combination of Rhodes and Curtin teaches the method of claim 31, wherein said comparing is performed at a device different from a device at which said associating is performed (Rhodes, fig. 7-8, [0047-0058].),

wherein said comparing is performed at a device different from a device at which said sending is performed (Rhodes, fig. 7-8, [0047-0058].).

Regarding dependent claims 63-64, 70-71, 78-79, the combination of Rhodes and Curtin teaches the method of claim 62,

wherein said receiving a confirmation request includes receiving said confirmation request via port-to-port communication (Rhodes, fig. 8, [0047-0059]. See also fig. 2-3.);

wherein said responding to said confirmation request includes responding via port-to-port communication (Rhodes, fig. 8, [0047-0059]. See also fig. 2-3.).

Regarding dependent claim 65, 72, 81, the combination of Rhodes and Curtin teaches the method of claim 62, wherein said receiving a confirmation request includes receiving a confirming electronic message (Rhodes, fig. 8, [0047-0059]. See also fig. 2-3.).

Regarding dependent claims 66, 68, 73, 75, 77, 82, 84, the combination of Rhodes and Curtin teaches the method of claim 65, wherein said confirming electronic message is one of a text message, VoIP message, or instant message, wherein said return electronic message is one of a text message, VoIP message, or instant message (Curtin, pg. 2/5, internet messages.).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Curtin and Rhodes in order to uniquely identify messages (Curtin, pg. 2/5, section 1.).

Regarding dependent claim 67, 74, 83, the combination of Rhodes and Curtin teaches the method of claim 62, wherein said responding to said confirmation request includes responding with a return electronic message (Rhodes, fig. 8, [0047-0059]. See also fig. 2-3.).

Regarding independent claims 62, 69, the combination of Rhodes and Curtin teaches the method comprising:

receiving a confirmation request to confirm that an electronic message sent to an intended recipient was authorized by an originator identified in the electronic message (Rhodes, fig. 8, [0058-0059], challenge message.),

the confirmation request including identification data purporting to uniquely identify the electronic message (Rhodes, fig. 8, [0058-0059], challenge message with originator key.); searching a data store for said identification data (Rhodes, [0058-0059], fig. 8, sender side confirmation of key.); and

upon determining that said data store contains said identification data, responding to said confirmation request, affirming the electronic message was authorized by the originator (Rhodes, [0058-0059], fig. 8, challenge response.).

Rhodes does not expressly disclose the identification data having been generated from at least a portion of the electronic message.

However, Curtin discloses the identification data having been generated from at least a portion of the electronic message (Curtin, pg. 2/5, section 1-3, Curtain discloses the generation of unique message IDs which are generated from a portion of the electronic message. Pg. 3/5-4/5, unique ID is generated using a hash of the message.).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Curtin and Rhodes in order to uniquely identify messages (Curtin, pg. 2/5, section 1.).

Regarding dependent claim 85, the combination of Rhodes and Curtin teaches the method of claim 31, wherein: the associating, storing and sending are at a sending module of a sending email system (Rhodes, fig. 2-3.); and

the receiving, comparing and responding are at a confirmation module of the sending email system (Rhodes, fig. 2-3. See also fig. 8.).

Regarding dependent claims 86-87, the combination of Rhodes and Curtin teaches the method of claim 62, wherein the receiving, searching and responding are at a confirmation module of a sending email system (Rhodes, fig. 2-3. See also fig. 8.).

Regarding dependent claim 88, the combination of Rhodes and Curtin teaches the method of claim 76, wherein receiving the first electronic message, sending the first confirmation request, receiving the response affirming said first electronic message was authorized by the originator, allowing said first electronic message to be further processed, receiving the second electronic message, and sending the second confirmation request are at a receiving email system (Rhodes, fig. 2-3, receiving mail system. See also fig. 8, receiving mail system.).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN J. JAKOVAC whose telephone number is (571)270-5003. The examiner can normally be reached on Monday through Friday, 7:30 am to 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ryan J. Jakovac/
Examiner, Art Unit 2445